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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/518,813	03/03/2000	Carr Franis Joseph	102286.412	6951

7590 10/20/2004

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EXAMINER

EPPERSON, JON D

ART UNIT	PAPER NUMBER
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1639

DATE MAILED: 10/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/518,813

Applicant(s)

JOSEPH ET AL

Examiner

Jon D Epperson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,7,8,15 and 58-65 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,7,8 and 15 is/are rejected.
- 7) ☒ Claim(s) 58-65 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Request for Continued Examination (RCE)***

1. A request for continued examination (RCE) under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection (i.e., see 7/26/04 Response). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/27/04 has been entered. Claims 1-11, 14, 15, 26-42 and 57-65 were pending. Applicants canceled claims 3-6, 9-14, 16-57 and amended claims 1, 2, 15 and 58. Therefore, claims 1, 2, 7, 8, 15 and 58-65 are currently pending. An action on the merit follows.

Those sections of Title 35, US code, not included in the instant action can be found in previous office actions.

### **Withdrawn Objections/Rejections**

2. All rejections and/or objections are withdrawn in view of Applicants' arguments and/or amendments.

### **New Rejections**

#### ***Claims Rejections - 35 U.S.C. 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 2, 7, 8 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Mattheakis et al. (WO 95/11922) (Publication Date is **May 4, 1995**).

For *claims 1*, Mattheakis et al. (see entire document) disclose methods for screening *in vitro* antibody display libraries (see Mattheakis et al., abstract), which anticipates claim 1. For example, Mattheakis et al. disclose (i) forming a first library, which comprises polynucleotide clones (e.g., see claim 30, step (1), "Constructing in vitro a library of DNA templates suitable for in vitro transcription"; see also, for example, figure 4 showing "cloning" site; see also figure 10). Mattheakis et al. further disclose (ii) expressing by *in vitro* transcription and translation an individual protein or polypeptide from each clone in the first library to form a second library, which comprises individual proteins and polypeptides derived from each polynucleotide clone in the first library (e.g., see claim 30, steps (2)-(3), "Introducing said library of DNA templates directly into an in vitro transcription/translation system ... translating *in vitro* said population of mRNA molecules forming polysomes displaying nascent peptides"; see also figure 10; see also Examples). Mattheakis et al. also disclose (iii) assaying the second library to select an individual protein or polypeptide in the second library having a biological activity of interest (e.g., see claim 30, steps (5)-(6), "contacting said polysome with an immobilized receptor ... selecting polysomes which are bound to the immobilized receptor"; see also figure 10; see also Examples). Finally, Mattheakis et al. disclose (iv) identifying the protein or polypeptide selected in step (iii) by sequencing a polynucleotide clone from the

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first library that encodes the individual protein or polypeptide selected from the second library in step (iii) (e.g., see claim 30, steps (6)-(8), “selecting polysomes which are bound to the immobilized receptor ... dissociating the bound polysomes and making cDNAs from the mRNAs of the bound polysomes ... sequencing the cDNAs”; see also figures 4 and 10).

For *claim 2*, Mattheakis et al. disclose the “ability to bind to another molecule” via antibody/antigen interactions (e.g., see figure 10 showing immobilized receptor).

For *claims 7-8*, Mattheakis et al. disclose the use of a microtiter plate and other array formats (e.g., see figure 2; see also page 7, lines 19-32).

For *claim 15*, Mattheakis et al. disclose in addition to the limitations stated above the use of cell samples as screening targets (e.g., see page 11, line 15, “The present invention also provides a method for affinity screening a library of polysomes displaying nascent peptides (including single-chain antibodies) for library members which bind to a ... “cell surface receptor”).

***Allowable Subject Matter***

4. Claim 58-65 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jon D Epperson whose telephone number is (571) 272-0808. The examiner can normally be reached Monday-Friday from 9:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on (571) 272-0811. The fax phone number for the organization where this application or proceeding is assigned is (571) 272-0811.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jon D. Epperson, Ph.D.  
December 20, 2003

BENNETT CELSA  
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to read 'Bennett Celsa', is written over the printed name and title.